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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,504	07/29/2002	Peter Brune	RBL0087	9383

7590 11/30/2004  
Baker & Daniels  
Suite 800  
111 East Waney Street  
Fort Wayne, IN 46802

EXAMINER

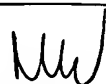
KARMIS, STEFANOS

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/089,504	Applicant(s) BRUNE ET AL.	
	Examiner Stefano Karmis	Art Unit 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All. b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. The following communication is in response to Applicant's amendment received on 19 August 2004.

#### ***Status of Claims***

2. Claims 1, 2, 4, 5, 7, and 9-13 are currently amended. Claims 3, 8, 14-19 are previously presented. Claim 6 is cancelled. Claims 20 and 21 are newly added. Therefore claims 1-5 and 7-21 are under prosecution in this application.

#### ***Summary of this Office Action***

3. Applicant's arguments, filed 19 August 2004, with respect to the rejection(s) of claim(s) 1-19 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made as discussed below.

#### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claim 7 is rejected under 35 U.S.C. 102(e) as being anticipated by Langseth et al.  
(hereinafter Langseth) U.S. Patent 6,694,316.

Regarding independent claim 7, Langseth teaches a method for charging Internet services via a mobile telephone, comprising coupling standard dealer software with standard (Internet) payment systems and Internet-enabled standard mobile telephone terminals (column 7, lines 27 thru column 8, line 52 and column 13 line 48 thru column 14, line 25 and column 15, lines 55-63).

### *Claim Rejections - 35 USC § 103*

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 1-5 and 8-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Neil (hereinafter O'Neil) U.S. Patent 6,226,364 in view of Langseth et al. (hereinafter Langseth) U.S. Patent 6,694,316.

Regarding independent claim 1, O'Neil teaches a method and system for using and charging services via a mobile telephone comprising the steps of:

establishing a payment gateway, which is accessible by a mobile telephone user via a mobile telephone terminal and by a provider via a provider server, there customer data of the user can be held centrally in a database of the payment gateway (column 17, line 49 thru column 18, line 17 and Figure 1);

opening a micropayment account at a bank, where the payment gateway and the micropayment account are continuously synchronized by means of a matching database (column 4, line 66 thru column 5, lines 24 and column 9, lines 43 thru column 10, line 8);

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reserving a certain amount in the micropayment account via the payment gateway and authorized by the user to the provider (column 9, lines 31-41);

the provider debiting amounts against the amount reserved (column 6, lines 11-28);

transmitting the actual charges from the provider to the payment gateway upon conclusion of the process (column 8, lines 19-43);

allocating the actual charges to the reserved certain amount, wherein the payment gateway debits the amounts to the micropayment account, credits the provider and cancels the respective reserved certain amount (column 8, lines 19-43).

O'Neil teaches an Internet service that activates a prepaid telephone card. O'Neil fails to teach charging and using via a mobile phone an Internet service. Langseth teaches a system and method for delivering Internet services to a mobile telephone and being charged for such a service (column 8, lines 31-52). It would have been obvious to one of ordinary skill in the art, that the transaction technique for services taught by O'Neil could have been modified to include Internet services as taught by Langseth because it provides an efficient manner to pay a service provider for a service delivered to a mobile phone with funds that are reserved in an account. Further, there is sufficient reason to combine, Internet services on mobile phones are charged in a similar manner as for telephone calls, based on the duration of the on-line time or the telephone call.

Claim 2, O'Neil teaches that no electronic money purse data and no customer data are held in the terminal (column 8, lines 3-5 and Figure 1).

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Claims 3 and 8, O'Neil teaches securing all payment transactions by means of a customer payment PIN (column 14, lines 46-65).

Claims 4 and 9-10, O'Neil teaches limiting sensitive data safely within the mobile telephone network and not transmitting sensitive data via the Internet (column 14, lines 46-65 and Figure 1).

Claims 5 and 11-13, O'Neil teaches authenticating the customer via the mobile telephone network (column 14, lines 46-65).

Claims 14-18, O'Neil teaches the reserving step receives matching data relating to the reserved certain amount from the user terminal and the provider (column 16, lines 9-20).

Regarding independent claim 19, O'Neil teaches a method and system for using and charging services via a mobile telephone comprising the steps of:

authenticating a mobile telephone user via a mobile telephone network (column 14, lines 46-65 and Figure 1).

establishing a payment gateway, which is accessible by a mobile telephone user via a mobile telephone terminal and by a provider via a provider server, there customer data of the user can be held centrally in a database of the payment gateway (column 17, line 49 thru column 18, line 17 and Figure 1);

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opening a micropayment account at a bank, where the payment gateway and the micropayment account are continuously synchronized by means of a matching database (column 4, line 66 thru column 5, lines 24 and column 9, lines 43 thru column 10, line 8);

reserving a certain amount in the micropayment account via the payment gateway and authorized by the user to the provider (column 9, lines 31-41);

the provider debiting amounts against the amount reserved (column 6, lines 11-28);

transmitting the actual charges from the provider to the payment gateway upon conclusion of the process (column 8, lines 19-43);

allocating the actual charges to the reserved certain amount, wherein the payment gateway debits the amounts to the micropayment account, credits the provider and cancels the respective reserved certain amount (column 8, lines 19-43).

O'Neil teaches an Internet service that activates a prepaid telephone card. O'Neil fails to teach charging and using via a mobile phone an Internet service. Langseth teaches a system and method for delivering Internet services to a mobile telephone and being charged for such a service (column 8, lines 31-52). It would have been obvious to one of ordinary skill in the art, that the transaction technique for services taught by O'Neil could have been modified to include Internet services as taught by Langseth because it provides an efficient manner to pay a service provider for a service delivered to a mobile phone with funds that are reserved in an account. Further, there is sufficient reason to combine, Internet services on mobile phones are charged in a similar manner as for telephone calls, based on the duration of the on-line time or the telephone call.

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Claims 20 and 21, O'Neil fails to specify coupling standard dealer software with standard Internet payment systems and Internet enabled standard mobile telephone systems. Langseth teaches a method for charging Internet services via a mobile telephone, comprising coupling standard dealer software with standard (Internet) payment systems and Internet-enabled standard mobile telephone terminals (column 7, lines 27 thru column 8, line 52 and column 13 line 48 thru column 14, line 25 and column 15, lines 55-63). It would have been obvious to one of ordinary skill in the art, that the transaction technique for services taught by O'Neil could have been modified to include coupling the necessary software as taught by Langseth because it provides an efficient manner to pay a service provider for a service delivered to a mobile phone with funds that are reserved in an account utilizing a communication medium that all parties have access and knowledge of.

### *Response to Arguments*

10. Applicant's arguments with respect to claims 1-5 and 7-19 have been considered but are moot in view of the new ground(s) of rejection.

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***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stefano Karmis whose telephone number is (703) 305-8130. The examiner can normally be reached on M-F: 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Respectfully Submitted  
Stefano Karmis  
23 November 2004



HANI M. KAZIL  
PRIMARY EXAMINER